

**REMARKS**

Favorable reconsideration and allowance of the subject application are respectfully requested in view of the following remarks.

**Summary of the Office Action**

Claims 1-3, 5, 6 and 8 stand rejected under 35 U.S.C. §102(b) as being anticipated by *Watanabe* (U.S. Patent No. 5,091,746).

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Watanabe* in view of the related art section of the present application.

Claim 4 stands objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form.

**Summary of the Response to the Office Action**

A copy of the United States Patent and Trademark Office postcard receipt stamped November 10, 1999 is submitted herewith. Applicants have amended claims 1, 4, 5 and 8 by this amendment. Claims 9-15 have been newly added. Accordingly, claims 1-15 are currently pending.

**Information Disclosure Statement**

Applicants respectfully request consideration of the Information Disclosure Statement filed on November 10, 1999. The Information Disclosure Statement and the accompanying Form PTO-1449 with two documented listed thereon were submitted and stamped received by the United States Patent and Trademark Office on November 10, 1999, as evident on the enclosed copy of the United States Patent and Trademark Office postcard receipt stamped November 10, 1999. Accordingly, Applicants respectfully request that the Examiner consider the Information Disclosure Statement, evidence that consideration by making appropriate

notations on the accompanying PTO Form 1449, and return a copy of the initialed PTO Form 1449 with the next office communication.

**The Disposition of the Claims**

Applicants appreciate the Examiner's indication that claim 4 would be allowable if rewritten in independent form. Claim 4 has been rewritten in independent form. Accordingly, it is respectfully submitted that claim 4 is in condition for allowance.

In addition, while Applicants agree that claim 4 is allowable and patentably distinguish over the prior art, Applicants respectfully do not acquiesce that patentability resides only in the features expressed in paragraph 6 of the Office Action, nor that each and every feature recited in the claim is required for patentability.

Further, claims 1-3 and 5-8 are also believed to be allowable for at least the following reasons.

**Claim Rejection Under 35 U.S.C. §102(b)**

Claims 1-3, 5, 6 and 8 stand rejected under 35 U.S.C. §102(b) as being anticipated by *Watanabe*. To the extent that this rejection might be applied to the claims, as newly-amended, it is respectfully traversed for at least the following reasons.

Applicants respectfully submit that *Watanabe* does not anticipate claims 1-3, 5, 6 and 8 because *Watanabe* does not disclose all of the features of these claims. For instance, it is respectfully submitted that *Watanabe* does not teach or suggest the claimed combinations as set forth in independent claims 1 and 8, as newly-amended, including at least "a discriminating part that, using the original image data generated by the image data generating part, judges whether a predetermined inhibit image is included in the original image or not," and "a working part that, if the discriminating part judges that the inhibit image is included in the original image, works on

the original image data including the inhibit image data to render an altered image different from the original image and then outputs the altered image data thus obtained.”

In addition, it is respectfully submitted that *Watanabe* does not teach or suggest the claimed combination as set forth in independent claim 5, as newly-amended, including at least “discriminating step of judging whether a predetermined inhibit image is included in the original image or not by using the original image data generated in the inputting step,” and “working step of, if it is judged at the discriminating step that the inhibit image is included in the original image, working on the original image data including the inhibit image data to render an altered image different from the original image and then outputting the altered image data thus obtained.”

The Office Action cites column 12, line 12 – column 13, line 31 of *Watanabe*’s disclosure as allegedly teaching Applicants’ claimed combinations. However, this portion of *Watanabe*’s disclosure merely discusses an operation when a portion of the touch panel (2d) corresponding to “masking” is pressed and a masking area (M1) is encircled on an original by a special pen using a special color such as blue ink. See, for example, FIG. 3, FIG. 25, column 4, lines 49-50, column 12, lines 12-13 of *Watanabe*. The Office Action appears to analogize *Watanabe*’s blue ink marks as the inhibit image as set forth in Applicants’ claimed combinations. However, the arrangement of *Watanabe* determines and knows the presence of the blue ink marks through the pressing of the “masking” operation on the touch panel (2d) before any image is scanned from an original. Thus, it is respectfully submitted that *Watanabe* fails to teach or suggest the claimed combinations as set forth in independent claims 1 and 8 including at least “a discriminating part that, using the original image data generated by the image data generating part, judges whether a predetermined inhibit image is included in the original image or not.”

Similarly, it is respectfully submitted that *Watanabe* fails to teach or suggest the claimed combination as set forth in independent claim 5 including at least “discriminating step of judging whether a predetermined inhibit image is included in the original image or not by using the original image data generated in the inputting step.”

In addition, the Office Action alleges that *Watanabe* teaches deleting the blue ink encircled elements and analogizes this deletion as the working part that works on the image data to render an image distinctly different from the original image, as set forth in Applicants’ claimed combinations. However, *Watanabe* merely teaches that once masking processing is selecting through the touch panel (2d), the main controller (101) causes the copying section (103) to perform copying first by using a blue filter (112B) and storing a first type of output digital signal in a memory (104), and then by using a red filter (112R) and storing a second type of output digital signal in the memory (104). See column 12, lines 18-20, 31-35, and 44-47 of *Watanabe*. Further, “[t]he main controller 101 then performs color discrimination of the image data stored in the memory 104. More specifically, e.g., addition and/or subtraction is performed between two types of image data, a blue portion of the original image is discriminated, and [the blue portion] position data is stored [as the masking area] in the memory 104.” Column 12, lines 53-60 of *Watanabe*. Subsequently, according to *Watanabe*, the original is optically scanned and the “main controller 101 drives the shutter in accordance with the masking area stored in the memory 104 to block the light reflected by the original.” Column 13, lines 5-7 of *Watanabe*. As a result, a paper sheet P as shown in FIG. 26 of *Watanabe* as “the copy of the original shown in FIG. 25 with the original portion surrounded in blue ink M1 masked, namely deleted.” Column 13, lines 27-30 of *Watanabe*.

Thus, the arrangement of *Watanabe* scans an original for at least three times, such that during the last scan, it avoids scanning or collecting the reflected light from the blue portion based on the position data of the blue portion determined based on image sets collected from the previous scans. That is, *Watanabe* does not discriminate using an original image data and work on the same image data to render an altered image. Hence, it is respectfully submitted that *Watanabe* also fails to teach or suggest the claimed combinations as set forth in independent claims 1 and 8 including at least “a working part that, if the discriminating part judges that the inhibit image is included in the original image, works on the original image data including the inhibit image data to render an altered image different from the original image and then outputs the altered image data thus obtained.” Similarly, it is respectfully submitted that *Watanabe* also fails to teach or suggest the claimed combination as set forth in independent claim 5 including at least “working step of, if it is judged at the discriminating step that the inhibit image is included in the original image, working on the original image data including the inhibit image data to render an altered image different from the original image and then outputting the altered image data thus obtained.”

M.P.E.P. § 2131 states “[t]o anticipate a claim, the reference must teach every element of the claim.” Applicants respectfully submit that since *Watanabe* does not teach or suggest all of the features of independent claims 1, 5 and 8, as newly-claimed, *Watanabe* does not anticipate claims 1, 5 and 8. Further, since claims 2, 3 and 6 depend from claims 1 and 5, it is respectfully submitted that *Watanabe* also does not anticipate claims 2, 3 and 6. Accordingly, withdrawal of the rejection of claims 1-3, 5, 6 and 8 under 35 U.S.C. §102(b) is respectfully requested.

**Claim Rejection Under 35 U.S.C. §103(a)**

Claim 7 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Watanabe* in view of the related art section of the present application.

Applicants respectfully submit that the related art section of the present application is not relied upon as teaching a discriminating part and a working part, and fails to remedy the above-mentioned deficiencies of *Watanabe*. Thus, it is respectfully submitted that *Watanabe* in view of the related art section of the present application does not render claim 1 unpatentable. Since claim 7 depends from claim 1, it is respectfully submitted that *Watanabe* in view of the related art section of the present application also do not render claim 7 unpatentable. Accordingly, withdrawal of the rejection of claim 7 under 35 U.S.C. 103(a) is respectfully requested.

**New Claims 9-15**

Applicants have added new claims 9-15 to differently define the invention. Applicants respectfully submit that claims 9-14 are allowable at least because of their dependence from claims 1, 5 and 8.

Further, it is respectfully submitted that none of the applied references teaches or suggests the claimed combinations as set forth in claims 9 and 13 including at least “wherein the working part inverts a gradation of at least one color signal of the inhibited image data portion to render the altered image.” Moreover, it is respectfully submitted that none of the applied references teaches or suggests the claimed combination as set forth in claim 11 including at least “wherein the step of working on the inhibit image data portion includes inverting a gradation of at least one color signal of the inhibited image data portion to render the altered image.”

Applicants further respectfully submit that claim 15 is allowable at least because none of the applied references teaches or suggests the claimed combination as set forth in claim 15

including at least “a discriminating part that, using the original image data generated by the image data generating part, judges whether a predetermined inhibit image is included in each of the original images or not,” and “a working part that, if the discriminating part judges that the inhibit image is included in the original images, works on the original image data including the inhibit image data to render an altered image different from the original image and then outputs altered image data thus obtains.”

**Conclusion**

In view of the foregoing, withdrawal of the rejections and allowance of the pending claims are earnestly solicited. Should there remain any questions or comments regarding this response or the application in general, the Examiner is urged to contact the undersigned at the number listed below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310.

If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,  
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